

REMARKS**1. Non-compliance.**

Applicant received the Notice of Non-Compliant Amendment because claims were withdrawn and new claims added, but no additional claims fee was submitted. As the withdrawn claims were directed to a non-elected species, and the original election was made without traverse, the claims should have been cancelled. In this Response, the non-elected claims are being cancelled, which should make this Response compliant. The remainder of this Response is identical to the Response filed by fax on 19 January 2005. This response is being submitted within the 1-month period granted in the Notice of Non-Compliant Amendment and no additional fees are due.

2. Claims Amendments.

Claims 1-11 have been amended to describe the invention with more clarity. Specifically, these claims have been amended to claim an informational real estate flyer distribution and creation method as disclosed in the Specification as originally filed. No new matter has been added.

Claims 12-42 have been cancelled from consideration as directed to non-elected inventions.

New Claims 43-52 have been added. New independent Claim 43 is identical to amended Claim 1, but for the specifics of a piece of real property only. New Claim 44 is identical to amended Claim 2, but dependent from Claim 43. New Claims 44-46 are identical to amended Claims 9-11 respectively, but dependent from Claim 44. New independent Claim 48 is identical to amended Claim 1, but for the specifics of an event only. New Claim 49 is identical to amended Claim 5, but dependent from Claim 48. New Claims 50-52 are identical to amended Claims 9-11 respectively, but dependent from Claim 48. No new matter has been added.

3. US Patent No. 6735604 To Miller Does Not Anticipate Or Make Obvious The Present Invention As Disclosed And Claimed.

Claims 1, 2, 5, and 8-11 have been rejected under 35 USC 102 as being anticipated by US Patent No. 6735604 to Miller (Miller '604), and Claims 1, 3, 4, 6, and 7 have been rejected under 35 USC 103 as being obvious over Miller '604.

These two rejections will be handled together as Miller '604 is the only cited reference used to reject the claims and as Miller '604 is not applicable to the present invention as originally filed and with the clarified claims.

a. US Patent No. 6735604 To Miller Does Not Anticipate The Present Invention As Disclosed And Claimed.

Anticipation under 35 USC 102(b) requires "the disclosure in a prior art reference each and every element of the claimed invention." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986); *see also verdegall Bros. V. Union Oil Co. of California*, 814 F2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference"). The absence of one element from the cited prior reference negates anticipation. *See Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 224 USPQ2d 409 (Fed Cir. 1984). As discussed below, Miller '604 does not disclose or claim each element of the present invention as claimed.

Prior art for the purposes of anticipation is pertinent art recognized by persons of ordinary skill to be in the **field of the invention**. *See In re Spada* 15 USPQ2d 1655, 1657 (Fed.Cir.1990). Prior art is pertinent if persons of ordinary skill in the art would have consulted art in that field to develop the invention given the nature of the problem. *See In re Paulsen*, 31 USPQ2d 1671 (Fed. Cir. 1994). Specifically, the pertinence of any reference is dependent upon whether it would suggest to persons skilled in the art to do the thing that the applicant has done, and the same is true in considering more than one reference or a reference alleged not to be in the particular art. *See In re Phipps*, 69 USPQ 88 (CCPA 1946). As discussed below, Miller '604 would not be considered to be in the same field of the present invention by those of ordinary skill in the art.

Miller '604 is, as its Abstract states, an automated "method of collecting, categorizing, indexing, storing and retrieving large amounts of data from a wide variety of sources. The invention discloses the use of location and industry templates to categorize documents and other data objects. Location and industry data for each document is translated into a set of assignment numerals that are used to create a header number. Each document or data object is indexed and stored in a data warehouse in accordance with the header number. Subsequently, documents

and data objects are retrieved from the data warehouse using the index of header numbers and the location and industry templates." The present invention is not such a complicated database tool, but is a method for inputting data into a template for the creation of promotional materials, namely informational flyers. The present invention does not categorize documents, does not create a unique header number, and does not even come close to being related to Miller '604.

In fact, Claim 1 of Miller '604 requires:

1. A method of storing data objects in a data warehouse, comprising:
 - receiving a data object;
 - identifying a geographic location to which the data object is related;
 - associating a numeric representation with the geographic location;
 - identifying an industry to which the data object is related;
 - associating a numeric representation with the industry; and
 - indexing the data object in the data warehouse based on a header number, the header number including the numeric representations of the geographic location and the industry.

The present invention at most has "receiving a data object" in common with Miller '604 (all the independent claims of Miller '604 require most of the elements of Miller '604 Claim 1). All of the other elements that the examiner has picked out of Miller '604 are unrelated to the present invention as claimed and, at most, merely are common elements to relational database applications, of which the present invention is *not*. Further, the examiner has taken bits and pieces of Miller '604 that are at best common elements of database technology and has applied them broadly to the present invention, combining them in a manner unintended by Miller '604 and resulting in a combination unlike the present invention.

The Federal Circuit has applied anticipation narrowly. For example, in an analogous case, the Federal Circuit affirmed a district court determination that patents related to a ceramic welding process for repairing industrial furnaces were not invalid for anticipation, notwithstanding that the claims of the patents overlapped with or read on either or both of two prior art patents, because the district court properly determined that the prior art patents were related to flame-spraying and to combustion at the furnace wall. See *Glaverbel Societe Anonyme And Fosbel, Inc. v. Northlake Marketing & Supply, Inc.*, 33 USPQ2d 1496 (Fed Cir. 1995). Even though

both inventions had a general relation to combustion, they were not so related that one of ordinary skill in the ceramic welding art would look to the flame-spraying art or the furnace wall combustion art. For the sake of argument, but not conceding, even if both Miller '604 and the present invention are related to the database field, they are not so related that one of ordinary skill in the data warehousing field (Miller '604) would look to the informational flyer creation and distribution field (the present invention) for inspiration. As now claimed, the present invention is even further from the data warehousing field.

Further, the present invention does not have each and every element of Miller '604, Miller '604 cannot and does not anticipate the present invention as claimed. Somewhat more specifically, the present invention does not identify a geographic location to which a data object is related, does not associate a numeric representation with the geographic location, does not identify an industry to which the data object is related, does not associate a numeric representation with the industry, does not index a data object in a data warehouse based on a header number, and does not have a header number including a numeric representation of a geographic location and an industry.

As the present invention does not have each and every element of Miller '604 and as Miller '604 does not disclose each and every element of the present invention as claimed, Miller '604 cannot and does not anticipate the present invention as claimed, and Applicant requests that this ground for rejection be withdrawn.

b. US Patent No. 6735604 To Miller Does Not Make Obvious The Present Invention As Disclosed And Claimed.

For a claim to be determined obvious (or nonobvious) under 35 USC 103, the claimed material must have been obvious to person of ordinary skill in the art from the prior art. An obviousness determination requires examining (1) the scope of the prior art, (2) the level of skill in the art, and (3) the differences between the prior art and Applicant's invention. *Litton Systems, Inc. v. Honeywell, Inc.*, 117 SCt 1270 (1970). A mere suggestion to further experiment with disclosed principles would not render obvious an invention based on those principles. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 19 USPQ2d 1432 (Fed. Cir. 1991). In fact, an applicant may use a reference as his basis for further experimentation and to create his invention. *Id.* As

discussed below (and as alluded to above in the previous section), Miller '604 has no discussion of entering information regarding real estate into a system for creating and distributing informational flyers about the real estate.

The fact that each element in a claimed invention is old or unpatentable does not determine the nonobviousness of the claimed invention as a whole. *See Custom Accessories, Inc., v. Jeffrey-Allan Industries*, 1 USPQ2d 1196 1986 (Fed. Cir. 1986). The prior art must not be given an overly broad reading, but should be read in the context of the patent specifications and **as intended by reference authors**. *Durling v. Spectrum Furniture Co.*, 40 USPQ2d 1788 (Fed Cir 1996) (Federal Circuit held that district court erred by giving a "too broad an interpretation" of claims in a sofa patent to invalidate another on the nonobviousness standard). Miller '604 was written for and teaches a specific data warehousing application and does not teach and is not related to the creation of informational materials in general and informational flyers related to real estate in particular.

The Federal Circuit has defined and determined the bounds of the prior art to be identical for both nonobviousness and anticipation purposes. *See In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994). Prior art for these purposes is pertinent art recognized by persons of ordinary skill to be in the **field of the invention**. *See In re Spada* 15 USPQ2d 1655, 1657 (Fed.Cir.1990), *In re Horne*, 203 USPQ 969, 971 (CCPA 1979). Prior art is pertinent if persons of ordinary skill in the art would have consulted art in that field to develop the invention given the nature of the problem. *See In re Paulsen*, 31 USPQ2d 1671 (Fed. Cir. 1994). Specifically, the pertinence of any reference is dependent upon whether it would suggest to persons skilled in the art to do the thing that the applicant has done, and the same is true in considering more than one reference or a reference alleged not to be in the particular art. *See In re Phipps*, 69 USPQ 88 (CCPA 1946). Nonanalogous prior art cannot properly be considered prior art under 35 USC 103. *In re Pagliaro*, 210 USPQ 888, 892 (CCPA 1981). As mentioned above in the previous section, for the sake of argument, but not conceding, even if both Miller '604 and the present invention are related to the database field, they are not so related that one of ordinary skill in the data warehousing field (Miller '604) would look to the informational flyer creation and distribution field (the present invention) for

inspiration. As now claimed, the present invention is even further from the data warehousing field. Thus, Miller '604 would not suggest to persons skilled in the data warehousing art (Miller '604) or the informational materials creation and distribution art (the present invention) to do the thing that Applicant has done.

The Federal Circuit has made it clear that the nonobviousness standard is applied wrongly if a court or an examiner: (1) improperly focuses on "a combination of old elements" rather than the invention as a whole; (2) ignores objective evidence of nonobviousness; (3) pays lip service to the presumption of validity; and (4) fails to make sufficient *Graham* findings. *Custom Accessories, Inc.*, 1 USPQ2d 1196 (Fed. Cir. 1986). Applying the nonobviousness test counter to these principles counters the principle that a patent application is presumed nonobvious. *Id.* All of the elements that the examiner has picked out of Miller '604 in rejecting the claims of the present invention are unrelated to the present invention as claimed and, at most, merely are common elements to relational database applications, of which the present invention is *not*.

To sustain a rejection under 35 USC 103, the examiner must establish a *prima facie* case of obviousness. MPEP §2142. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143. This just is not the case with the present invention. At most, the examiner has discussed minor elements common to all applications requiring a database, and not the elements required by the present invention to perform the method as disclosed and claimed.


As the present invention is not fairly taught by or related to the subject matter of Miller '604, Miller '604 cannot and does not make obvious the present invention as claimed, and Applicant requests that this ground for rejection be withdrawn.

CONCLUSION

Applicant submits that the application is in condition for examination and allowance and respectfully requests such actions.

If the examiner has any questions that can be resolved over the telephone, the examiner is invited to contact the below-signed attorney of record.

Respectfully submitted,
TECHNOPROP COLTON LLC


Laurence P. Colton
Reg. No. 33,371

TECHNOPROP COLTON LLC
PO Box 567685
Atlanta GA 31156-7685
Tel: 770.522.9762
Fax: 770.522.9763
E-Mail: technoprop@technoprop.com